

From: Moatz, Harry
Sent: Wednesday, March 24, 2004 11:02 AM
To: Hanson, Steve
Cc: Valentine, Steve (NAI)
Subject: FW: IPO Comments -- PTO Ethics Rules, 68 Fed. Reg. 69442 (Dec. 12, 2003)
Importance: High

For inclusion in Webpage and in hardcopy book.

-----Original Message -----

From: dana@ipo.org [mailto:dana@ipo.org]

Sent: Tuesday, March 23, 2004 1:45 PM

To: ethicsrules comments

Subject: IPO Comments -- PTO Ethics Rules, 68 Fed. Reg. 69442 (Dec. 12, 2003)

Importance: High

Attached are IPO Comments on the PTO's proposed rules related to "Changes to Representation of Others Before The United States Patent and Trademark Office," Fed. Reg. 69442 (Dec. 12, 2003). IPO is aware that the deadline for comment on parts of this rule package has been extended; the attached addresses some sections for which time has NOT been extended but we hope that all of our comments can be considered.

Thank you. Please confirm receipt of this email.

Mr. Dana Robert Colarulli

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March 23, 2004

Hon. Jon W. Dudas
Acting Director
U.S. Patent and Trademark Office
Mail Stop OED-Ethics Rule
P.O. Box 1450
Alexandria, VA 22313-1450

Attention: Harry I. Moatz

**RE: Comments Regarding Changes to Representation of Others Before
the USPTO Federal Register Notice: 68 Fed. Reg. 69442 (December 12, 2003)**

Dear Director Dudas:

The following are the comments of Intellectual Property Owners Association IPO with respect to the proposed new rules for Representation of Others Before the USPTO published in a notice in the Federal Register on December 12, 2003 (68 Fed. Reg. 69442).

IPO is a trade association for owners of patents, trademarks, copyrights and trade secrets. IPO's membership includes 100 large and mid-size companies and 250 small businesses, universities, inventors, authors, executives, law firms and attorneys. Most members of IPO's Board of Directors are chief intellectual counsel in U.S. companies. IPO serves all intellectual property owners in all industries and all fields of technology. IPO advocates effective protection for patents, trademarks, copyrights, and trade secrets and also urges laws that provide reasonable certainty to avoid undue litigation. The new proposed rules by the USPTO will have a significant effect on our members and their employees, as well as others in the patent community, who practice before the USPTO in patent and trademark matters. Therefore, IPO appreciates the opportunity to provide its

comments on the rule changes and changes in Office procedure as proposed in the notice.

The comments below address the rule changes proposed for Parts I and 2, and to the new rules proposed in Part 11, Subparts A-C of title 37 of the Code of Federal Regulations. The time period for commenting on the Rules of Professional Conduct (Part 11, Subpart D) and certain other rules, several of which are addressed in this letter, has been extended through June 11, 2004. IPO appreciates the fact that the Office has extended the time to present comments on Subpart D in view of the significant changes that are proposed and also in view of the enormous complexity of the proposal presented in the notice published on December 12, 2003.

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COMMENTS

The following are general comments regarding the proposed changes in rules of Parts 1 and 2 and in the new rules in Part 11. There were numerous instances where rules were cross-references in a proposed rule change or a proposed new rule, and the crossreferenced rule either did not exist or appears to be incomplete. For example, in Part 1, proposed amended Rule 1.4 cross references proposed new Rule 11.804(i)(15) and the comments in the notice at column 3 of page 69442 with respect to a proposed revision of Rule 1.4 cross-reference proposed new Rule 11.804(c)(i)(15). However, neither of the cross-referenced rules exists. Accordingly, whatever the final rules may be, the Office should verify the cross-referenced rules to insure that they are correct citations. Also, some of the new rules set time periods, but there is inconsistency in nomenclature. Some of the proposed rules have the numeric form while others use the written form and still others have the written form with the numeric form in parenthesis. For consistency, it is suggested that the time period be in written form with the numeric form in parenthesis since the number is an eye catcher and easier to read.

Part 1

Proposed Rule 1.21(a)(6): In view of the proposed removal of Part 10, proposed rule 1.21(a)(6) would not be necessary. Clarification is needed.

Part 2

Rule 2.119: The proposed revision of the Trademark rules does not include a revision to Rule 2.119. Paragraph (d) of that rule makes reference to Rules 10.14(a), 10.14(b) and 10.14(c). Since it is proposed to remove Part 10, Rule 2.119 should be revised accordingly.

Part 11

Proposed Rule 11.1: The proposed rule contains definitions of terms used in the new rules of Part 11. However, the terms and phrases defined are not complete. Other definitions, not found in proposed Rule 11.1, have been embedded in the proposed rules themselves. For example, the term "moral character" is defined in Rule 11.7(h). The term is used in a number of other proposed rules other than Rule 11.7(h). For example, a person reading proposed Rule 11.7(i) or 11.9(a) or 11.11(d)(6) may not know that "moral character" was defined in Rule 11.7(h). Therefore, it is suggested that the definition of a term or phrase which is presently embedded in the rules be placed in Rule 11.1 since the rule is a quick and easy reference point for a person to find a definition. Also, it is noted that several terms and phrases in the new rules have not been defined anywhere in the new rules. For example, terms such as "moral turpitude," "informed consent" and "full disclosure" as used in a number of rules of the Rules of Professional Conduct lack definition. These terms are ambiguous and need to be defined in proposed Rule 11.1 so that the public is informed of their scope and meaning.

Intellectual Property Owners Association (IPO)

Proposed Rules 11.72(c) and 11.7(c): The proposed rules permit a separate appeal to the Director of OED of a requirement, decision or action taken by an OED staff member. This type of appeal, in effect, is a petition for supervisory review which is similar to present Rule 1.181. However, the proposed rule requires the fee set forth in proposed Rule 1.21(a)(5) whereas Rule 1.181 does not require a fee. For consistency, the type of petition proposed in Rule 11.7(c) should not have a fee. The petitioner should be able to seek review of a requirement, decision or action taken by an OED staff person without having to pay a fee. Also, Rule 1.181 (f) provides that the petition can be filed within two (2) months after the "action complained of" whereas the proposed rule requires that the petition must be filed within "thirty days after the date of the action complained of." Therefore, it is suggested that the period for filing the petition be two (2) months, and not "thirty days."

Proposed Rule 11.2(c): The proposed rule states that "The filing of a petition will not stay the period for taking other action, including the timely filing of an application for registration, which may be running, or act as a stay of other proceedings." This provision would discourage individuals seeking to be registered from filing legitimate appeals of a decision, requirement or action of an OED staff member if the issue for such a petition for review centers on filing an application for registration. Also, the phrase "other proceedings" is not understood and should be defined. The provision would not provide any assurance that a decision by the OED Director would be promptly decided so as not to interfere with rights of the petitioner or applicant for registration.

Proposed Rule 11.3(d): The proposed rule states that "Complaints submitted to the OED Director or any other official of the Office shall be qualifiedly privileged for the purpose that no claim or action in tort predicated thereon may be instituted or maintained." We object to the qualified privilege because a falsely accused practitioner should be entitled to remedial tort action should the complaint be groundless and the practitioner's practice or reputation is injured by the complaint. Also, the last part of proposed rule 11.3(d) is directed to a separate immunity and provides that "employees of the Office providing regrades of examinations" are immune from liability. There is no provision for regrades under the new proposed rules. Therefore, clarification of this portion of the proposed rule is needed.

Proposed Rule 11.6(d): The proposed rule gives the Chief Administrative Patent Judge or his or her deputy authority to determine if a non-registered practitioner can take testimony in an interference matter. Should there also be a similar rule for a nonpractitioner to take deposition testimony in public use proceedings under 37 CFR § 1.292?

Proposed Rule 11.7: The proposed rule is directed to the requirements for registration. Throughout the proposed rule, the terms "a form supplied by the OED Director," "application for admission," "registration application," "complete application," "applications," "application," "application form," and "application form supplied by the OED Director" are used. It is not clear whether all of these terms have the same meaning or whether they represent different forms and/or different types of applications. The definition of "application" in proposed Rule 11.1 does not pertain to the type of

Intellectual Property Owners Association (IPO)

application as used in the context of proposed Rule 11.7. It is believed that the applications and form supplied by the OED Director referred in proposed Rule 11.7 pertain to the application for registration to practice before the Office in patent cases. The use of the term "application" in Rule 11.7 and the definition of "application" in Rule 11.1 could be confusing to a member of the public reading the rules who is not familiar with PTO practice and procedure. For clarity and consistency, it is suggested that the term "application for registration" be used when referring to the registration application and that the term as well as the phrase "form supplied by the OED Director" be defined in proposed Rule 11.1 so that their meanings are clearly distinguishable to the reader. Also, it is not clear what a "complete application" means. While the term "complete registration application" is defined in proposed Rule 11.7(b)(1)(i), the rule does not define "complete application" as used, for example, in proposed Rules 11.7(b)(2). Again, there should be consistency in the Rule in the use of terms. The lack of consistency raises an issue of ambiguity.

Proposed Rule 11.7(d): This proposed rule is directed to waiver of the registration examination for certain former Office employees. However, the purpose of the rule is not immediately apparent to the reader. Therefore, it is suggested that the rule be subtitled "Waiver of the Registration Examiner for Former Office Employees" followed by subsections (1), (2), etc. This would immediately let the reader know that the rule is directed to waiver of the examination for former PTO employees.

Proposed Rule 11.7(g): In the notice, the Office seeks comments on two alternatives on determining moral character of applicants seeking registration to practice before the OED who are attorneys. The first option would require these applicants "to submit a certified copy of their State Bar application and moral character determination." The second option "would require these applicants to submit a certified copy of their State Bar application and moral character determination and for the Office to accept the State Bar's character determination as meeting the requirements set forth in § 11.7(g) if, after review, the Office finds no substantial discrepancy between the information provided with their USPTO application **and the State Bar application**" **IPO is not** in favor of either option. Presently, attorneys, who are seeking registration must submit a certificate of good standing to OED from a State bar or the highest court to which they belong. The certificate of good standing implicitly is evidence of the attorney's good moral character and repute. Also, the registration application itself contains a number of questions to be answered by the registration applicant. A positive answer to any of the questions could be sufficient grounds to initiate an investigation regarding good moral character and reputation. The basis for why either of the two alternatives is necessary is not set forth in the comments of the Office. In addition, the comments have not set forth any compelling reasons why the Office would desire to require an attorney applicant for registration to submit a certified copy of the State bar application and the moral character report when the certificate of good standing is evidence that the applicant possesses "good moral character and reputation" as required by 35 U.S.C. § 2(d)(2)(D).

Intellectual Property Owners Association (IPO)

Proposed Rule 11.7(g)(1): The proposed rule requires the individual to "answer all questions." It is not known what is the source of the questions - the registration application, questions by OED in an information request or request for comments and/or from other unknown source. The source of the questions should be identified.

Proposed Rule 11.7(g)(3): The proposed rule states: "If the individual seeking registration or recognition is an attorney, the individual is not entitled to a disciplinary proceeding under § § 11.32-11.57 in lieu of moral character proceedings under paragraphs 0) through (m) of this section." This sentence is not understood. Under proposed Rule 11.32, only the OED Director can initiate a disciplinary proceeding if the Committee on Discipline finds probable cause that there has been a violation of the Rules of Professional Conduct. It is not clear how an attorney, who has not yet been registered to practice before the Office in patent cases or an attorney practicing before the Office in non-patent cases, would have authority under the proposed rules to initiate a disciplinary proceeding without action by the Committee on Discipline. Clarification of this rule is needed.

Proposed Rule 11.7(h): 35 U.S.C. § 2(b)(2)(D) states that the applicant for registration possess "good moral character and reputation" in describing the fitness of such an applicant to practice before the PTO. However, proposed Rules uses many different phrases such as "moral character" (11.7(h)(3)), "good moral character" (11.7(i)), "good character and reputation" (11.7(g)(1)), and "moral character and reputation" (11.70)(1)). Although proposed Rule 11.7(h) defines "moral character," it is not clear that this would be the same definition for "good moral character," "good character and reputation," and "moral character and reputation." Since the statute, 35 U.S.C. § 2(b)(2)(D) uses the phrase "good moral character and reputation," it is suggested that, for consistency, the rules use entire phrase as set forth in the statute, and not just a portion of it. If, however, the Office intended "moral character" to have a definition different from "good moral character and reputation," "good moral character," "moral character and reputation" or "reputation," then separate definitions should be presented in proposed Rule 11.1. Also, the proposed rule introduces the term "moral turpitude." This term has not been defined. It is suggested that the Office define what constitutes "moral turpitude" and add the definition to proposed Rule 11.1 in order to set a standard upon which the practitioner knows what constitutes a violation of a crime or misconduct involving moral turpitude.

Proposed Rule 11.8(d): This proposed rule requires that all registered practitioners shall pay an annual fee to maintain their registration. The time at which the payment of the annual fee is due would be based upon the first letter of the last name of the practitioner. According to the comments by the Office, the fee would cover the costs of the disciplinary system and maintaining the roster of attorneys and agents. IPO does not oppose the requirement for an annual fee; however, we are concerned about the potential that such fees will be diverted to support other programs. We understand that there are about 29,000 registered practitioners and we estimate that the annual fees from these practitioners, taking into account those who remove themselves from the roster, will be approximately, three million dollars. This is a significant amount and fee diversion is a

Intellectual Property Owners Association (IPO)

problem because the PTO does not have total control over its use of the funds it receives. Therefore, IPO is reluctant to endorse the imposition of this fee until the fee diversion problem is resolved.

Also, this program will require the use of additional resources which may not be available to handle the volume of paper that will be generated by the program. We understand that presently 1/5th of the roster is surveyed each year and that the annual fee program will replace the annual survey program. The present survey program requires registered practitioners to complete and return a data sheet to OED. We further understand that presently the annual fee program will be administered manually. While not explicitly required by the proposed rules, if the annual fee program will require the practitioner to complete and return a data sheet with the annual fee, this would impose a five fold increase in the OED administrative workload. There is no assurance that OED will be given the necessary resources to handle the volume of paper, especially at this time where the PTO is understaffed and lacks the authority to acquire additional resources. With respect to the time at which payment of the fee is due, we suggest a system that would permit large organizations to pay the fees for all their attorneys at the same time.

Finally, failure to pay the annual fee will have catastrophic consequences for the practitioner under proposed Rule 11.11(b) which would subject a practitioner to administrative suspension. Such failure can result in additional fees to be reinstated and possible discipline. The concern is not the failure to pay the fee, but an administrative mistake where the practitioner is not credited with paying the fee and continues to practice believing that he or she has satisfied the fee payment requirement. There is also the issue as to the status of the applications which the practitioner prosecuted between the date of the administrative suspension and the date the practitioner receives notice of the suspension. The inventor should not be penalized for an administrative failure on the part of his attorney. At the least, there should be a mechanism for the inventor to reinstate rights after a lapse by the attorney.

Proposed Rules 11.10(b)(1) and (b)(2): The Office is apparently trying to shoehorn in the statutory provisions of 18 U.S.C. §§ 207(a)(1) and (a)(2) into restrictions on former examiners. However, proposed Rule 11.10(b)(1) and (b)(2) appear to go beyond the restrictions set forth in the statute.

18 U.S.C. § 207(a)(1) provides, in part, that any former officer or employee of the Executive Branch "who, after the termination of his or her service or employment ..., knowingly makes, with the intent of influence, any communication to or appearance before any officer or employee of any department, agency, court, or court-martial of the United States or the District of Columbia, on behalf of any other person (except the United States or the District of Columbia), in connection with a particular matter - (A) in which the United States or the District of Columbia is a party or has a direct and substantial interest, (B) in which the person participated personally and substantially as such officer or employee, and (C) which involved a specific party or specific parties at

Intellectual Property Owners Association (IPO)

the time of such participation, shall be punished as provided in section of 216 of this title."

The proposed Rule 11.10(b)(1) goes beyond the statutory restrictions on former government employees. The limitations set forth in paragraphs (b)(1)(i) to (b)(1)(iii) are in the alternative, i.e., anyone of the conditions can be met whereas in the statute all three conditions (A), (B) and (C) must be met to have a violation. Also, the proposed rule includes the term "or" in the phrase "or with the intent to influence the making of any oral or written communication on behalf of any other person." 18 U.S.C. 207(a)(1) does not include "or." The introduction of "or" and using alternative language in proposed subsections (b)(1)(i) to (b)(1)(iii) renders the proposed rule confusing and imposes restrictions which are beyond those mandated by the statutory provisions of 18 U.S.C. § 207(a)(1).

18 U.S.C. § 207(a)(2) provides, in part, that any former officer or employee of the Executive Branch subject to the restriction set forth in 18 U.S.C. § 207(a)(1), "who, within two years after the termination of his or her service or employment ..., knowingly makes, with the intent of influence, any communication to or appearance before any officer or employee of any department, agency, court, or court-martial of the United States or the District of Columbia, on behalf of any other person (except the United States or the District of Columbia), in connection with a particular matter - (A) in which the United States or the District of Columbia is a party or has a direct and substantial interest, (B) which the person knows or reasonably should know was actually pending under his or her official responsibility as such officer or employee within a period of 1 year before the termination of his or her service or employment with the United States or the District of Columbia, and (C) which involved a specific party or specific parties at the time it was so pending, shall be punished as provided in section of 216 of this title."

Proposed Rule 11.10(b)(2) is patterned after 18 U.S.C. § 207(a)(2). The proposed rule, like proposed Rule 11.10(b)(1) contains "or knowingly ..." and the alternative language for subparagraphs (b)(2)(i) to (b)(2)(iii). Proposed Rule 11.10(b)(2) is objected to for the same reasons discussed above with respect to proposed Rule 11.10(b)(1). The introduction of "or" and using alternative language in proposed subsections (b)(2)(i) to (b)(2)(iii) renders the proposed rule confusing and imposes restrictions beyond those mandated by the statutory provisions of 18 U.S.C. § 207(a)(2).

We find the proposed rules to be confusing and to not adequately inform former employees of the Office or the public of the after employment restrictions. These proposed rules need to be revised to clarify what restrictions the Office intends to cover.

Proposed Rule 11.12(a) and (d): This proposed rule sets forth a requirement for mandatory continuing training for licensed practitioners under proposed Rules 11.6 and 11.9. The proposed rule speaks of "licensed" practitioners while proposed rules refer to such practitioners as "registered" practitioners. For consistency, it is suggested that the term "licensed" be changed to "registered."

Intellectual Property Owners Association (IPO)

IPO does not oppose the continuing education requirement set forth in the proposed rules. However, we understand that the program will be administered manually. In view of the fact that this will require processing paper for about 29,000 practitioners per year, a considerable amount of resources will be necessary to administer the program. This requirement would appear to be in addition to the resources required to administer the annual fee program. IPO is not convinced that the PTO will be able to provide service without shifting resources from other PTO program areas to OED. Also, for reasons similar to those set forth in the discussion of the annual fee requirement of proposed Rule 11.8(d), IPO is concerned with administrative errors in crediting practitioners with continuing education training credit. Such errors could result in additional fees for reinstatement, possible disciplinary action taken against practitioners who are improperly administratively suspended under proposed Rule 11.12(d) for alleged failure to satisfy the requirement and even loss of rights by inventors whose attorneys are administratively suspended. IPO is reluctant to endorse a program for which the PTO has not provided assurances that adequate resources will be provided and that adequate measures are provided to insure the accuracy of the record keeping in OED.

Proposed Rule 11.12(a): This rule indicates that the PTO Director will announce each year whether an education program will be required. It might be easier for practitioners to keep track of their continuing education obligations if a set number of hours of education were required over the three-year period. Most of the CLE programs accredited by the PTO will also be accredited by states.

Proposed Rule 11.13(f)(4): This rule specifically prohibits corporations and law firms from being sponsors in the continuing education program. The PTO in its comments to the rules has not set forth any rationale as to why corporations and law firms would be excluded. Many of our corporate and law firm members provide periodic programs that review recent court decisions and changes in the USPTO rules, practice and procedure to maintain currency in patent practice. Most of these programs are eligible for CLE credit by most States. The proposed rule favors private groups who may wish to promote these programs in lieu of in-house programs. IPO opposes the adoption of this rule.

Proposed Rule 11.16: In return for being registered, this proposed rule would allow OED to inspect the financial records of a practitioner. This would presumably include the nonpublic financial records of a corporation or a law firm. IPO objects to proposed rule on several grounds. First, it would be in violation of the 4th Amendment rights under the U.S. Constitution. The practitioner's financial books and records are property protected under the 4th Amendment. The 4th Amendment guarantees the "right of the people to be secure in their persons, houses, papers and effects, against unreasonable searches and seizures, shall not be violated, and no Warrants shall issue, but upon probable cause, supported by Oath and affirmation, and particularly describing the place to be searched, and the persons or things to be seized." The proposed rule does not comport with the requirement of securing a warrant based on probable cause supported by an oath or affirmation. Second, a rule cannot usurp the Constitution. A practitioner cannot give up this Constitutional right by rule without statutory authority. Third, if the financial records are open to inspection by OED, there are no safeguards in the proposed rule that

Intellectual Property Owners Association (IPO)

information will be secure and kept confidential and could not be obtained through FOIA requests and be improperly viewed by or reported to other Government agencies. Accordingly, IPO opposes the adoption of this rule.

Proposed Rule 11.19(c): This proposed rule defines "Misconduct - grounds for discipline." Proposed Rule 11.804 also defines "misconduct" differently from proposed Rule 11.19(c). Therefore, in order to distinguish the two rules, it is suggested that the subtitle of proposed Rule 11.19(c) be entitled "Grounds for Discipline." Also, proposed Rules 11.19(c)(iii) and (iv) are specifically identified as grounds for discipline. Paragraph (c)(iii) states that "Failure to comply with an order of a Court disciplining a practitioner, or any order of the USPTO Director disciplining a practitioner" is a ground for discipline. Paragraph (c)(iv) states that "failure to respond to a written inquiry from OED Director in the course of an investigation ..." is also a ground for discipline. However, according to proposed Rule 10.32, discipline can only be initiated if a majority of the Committee on Discipline finds probable cause that a Rule of Professional Conduct has been violated. Neither paragraph cites back to a Rule of Professional Conduct. Therefore, the basis for discipline is absent. Clarification is required.

Proposed Rule 11.20(a)(1)(ii): The term "indefinite period" is ambiguous. Is the time truly indefinite and can include a period more than 5 years or is it a period of time that cannot exceed more than 5 years? The proposed rule is not clear. Clarification is needed.

Proposed Rule 11.20(a)(2): The proposed rule allows for "dismissing the filing of an application with prejudice." There does not appear to be any statutory authority for the Office to dismiss the filing of an application. Therefore, the rule would appear to be beyond the scope of the authority and powers granted to the USPTO Director. IPO opposes the adoption of this portion of the proposed rule.

Proposed Rule 11.22(d)(1): Proposed rule 11.22 is directed to procedures for conducting investigations of "complaints" received by OED alleging ethical violations by a practitioner. The public could be confused by the definition of "complaint" as provided by this rule and the "complaint" as set forth proposed Rules 11.35 to 11.37, 11.41, 11.42 and 11.45. The latter "complaint" is a formal complaint filed by the OED Director to initiate a disciplinary proceeding against a practitioner after the Committee on Discipline has found probable cause that a Rule of Professional Conduct has been violated. It is suggested that the Office rename one "complaint" so that it can be distinguished from the other.

Proposed Rule 11.22(k): This proposed rule would allow OED to request financial records during an investigation without probable cause. For reasons stated with respect to its opposition to proposed Rule 11.16, IPO objects to proposed Rule 11.22(k). Examination of escrow accounts or trust accounts by OED would be limited to determining if the account conforms to the requirements set forth in § 11.115(a). With respect to all other financial records, OED would have to work within the framework of the 4th Amendment of the U.S. Constitution.

Intellectual Property Owners Association (IPO)

Proposed Rule 11.22(1): The proposed rule would allow taking a matter to the Committee on Discipline if a practitioner fails to provide financial records or "replies evasively" to an investigation by the OED Director. As for the first ground, for reasons already stated above with respect to proposed Rules 11.16 and 11.19(c), IPO is opposed to rules to opening financial records to OED without Constitutional safeguards. As for the second ground, the term "replies evasively" is ambiguous and is not defined in the rules so to put the public on notice as to what constitutes an evasive reply. Moreover, there is no provision in the Rules of Professional Conduct that an evasive reply is a violation of ethics rules to permit the Committee on Discipline to make a finding of a violation. Accordingly, IPO objects to the adoption of this portion of the proposed rule.

Proposed Rule 11.23(a): The proposed rule refers in general to the "General Counsel." The term "General Counsel" could be confused with the Department of Commerce General Counsel. It is suggested that the phrase "of the USPTO" be added after "General Counsel" so as to distinguish it from the PTO General Counsel of the Department of Commerce.

Proposed Rule 11.25(a) and (f): The proposed rules provide for interim suspension and discipline for crimes committed by practitioners. The rule uses the terms "moral turpitude" and "moral turpitude per se." These terms have not been defined. In order to apprise the public of what constitutes "moral turpitude" and "moral turpitude per se," these terms should be defined by the Office in proposed Rule 11.1 to place the public on notice as to what these terms mean.

Proposed Rule 11.49: The proposed rules are directed to the standard of proof in disciplinary proceedings. In its comments, the Office noted that it has been reported that the PTO "is among a minority of agencies that apply the clear and convincing standard in their disciplinary proceedings." The Office has asked for comments with respect to whether the "clear and convincing" standard should be changed to a "preponderance of the evidence." IPO does not object to the present standard and finds no compelling reason to change the burden of proof requirement as set forth in the proposed rule.

Proposed Rule 11.58(b): Existing rule 10.158(b)(1) gives a disciplined practitioner thirty (30) days to wind up his or her affairs. Proposed new Rule 11.58(b)(1) reduces the time period to twenty (20) days. If the twenty (20) day period is not a typographical error, the time period set in the proposed rule is unreasonable for a practitioner to comply with the requirements of the rule. The Office has not presented any reason in its comments to justify changing the time period from that set in § 10.158(b)(1). If the twenty (20) day period is a typographical error and the Office intended thirty (30) days, then the filing of an affidavit as required by proposed Rule 11.58(b)(2) should be set at forty-five (45) days after entry of the order of suspension, exclusion or exclusion by consent, or of acceptance of resignation since the practitioner may require the full 30 days to comply with the requirements of proposed Rule 11.58(b)(1) and will need extra time to prepare the required affidavit. This would allow time for the practitioner's attorney to review the

Intellectual Property Owners Association (IPO)

affidavit before it is filed in OED. We suggest more flexibility may be needed in proposed rule 11.58(B)(1)(vi), to cover situations in which another attorney may be able to administer accounts.

IPO appreciates the opportunity to provide comments on the proposed rules.

Sincerely,

Herbert C. Wamsley
Executive Director